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In re Application of :
KWONG et al. :
Application No.: 09/856,200 : DECISION ON PETITION
PCT No.: PCT/US98/23905 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 10 November 1998 :
Priority Date: 10 November 1997 :
Attorney Docket No.: 54203-H-CT/JPW/SHS :
For: CRYSTAL COMPRISING HUMAN
IMMUNODEFICIENCY VIRUS
ENVELOPE GLYCOPROTEIN GP120 . . .

This is a decision on applicant's "PETITION TO REVIVE AN UNINTENTIONALLY ABANDONED APPLICATION UNDER 37 CFR 1.137(b)" filed in the Patent and Trademark Office (PTO) on 14 May 2001.

BACKGROUND

On 03 March 1998, applicant filed international application PCT/US98/23905 which claimed a priority date of 10 November 1997 and which designated the United States. A proper Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 10 May 2000.

On 14 May 2001, applicant filed a transmittal letter requesting entry into the national stage in the United States, which was accompanied, inter alia, by: the basic national fee, a copy of the international application, and the present petition seeking revival under 37 CFR 1.137(b) with the appropriate fee.

DISCUSSION

Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to authorize the Commissioner to revive an "unintentionally" abandoned application without a showing that the delay in prosecution was "unavoidable." 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the

delay was unintentional." Where there is a question whether the delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989). The circumstances of the above-identified application raise a question whether the delay was "unintentional":

Where the applicant deliberately permits an application to become abandoned (e.g., due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of [37 CFR] 1.137(b). . . . An intentional delay resulting from a deliberate course of action chosen by the applicant is not affected by: (1) the correctness of the applicant's (or applicant's representative's) decision to abandon the application or not to seek or persist in seeking revival of the application; (2) the correctness or propriety of a rejection, or other objection, requirement, or decision by the Office; or (3) the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision not to seek or persist in seeking revival.

See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 86 (October 21, 1997)(citations omitted).

A review of the application file and specifically the "Declaration of John P. White" reveals that the entire delay cannot be held to be unintentional. In the declaration, it is stated that "[o]n May 09, 2000 . . . Ofra Weinberger instructed Mr. Landa that the PCT application would not enter the national or regional stage . . . I confirmed my understanding of Ofra Weinberger's instruction not to enter the national stage in a letter dated May 9, 2000 . . . During a May 23, 2000, Ofra Weinberger telephoned . . . to explain that she intended her instructions only to the designated 'foreign' countries, not the United States and that it was always her intention that the subject PCT application should enter the national stage in United States." The intentional delay in this case is not affected by Dr. Weinberger's "unintentional oversight" not to enter the national or regional stage." This action was a deliberate course of action as discussed above and, thus, resulted in an intentional delay in filing the required fee in compliance with 35 U.S.C. § 371(c) to enter the national stage in the United States.

Therefore, in view of the deliberately chosen course of action to not persist in seeking the revival of the abandoned application, the delay cannot be considered to be unintentional, and the petition may not be properly granted.

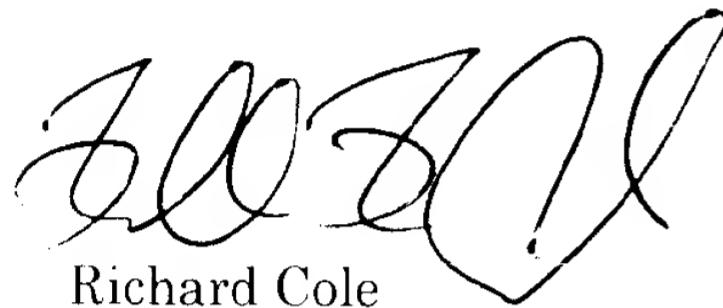
CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

The application remains **ABANDONED** with regards to national stage processing in the United States.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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